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EXAMINER

MOORE, MARGARET G

ART UNIT

PAPER NUMBER

1712

9

DATE MAILED: 07/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/759,031

Applicant(s)

YEATS ET AL.

Examiner

Margaret G. Moore

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 to 8, 11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 8, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

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1. Claims 1, 3 to 7, 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "reactive diluent" is a relative term in that what is considered "reactive" in certain conditions may not be considered reactive in other conditions. For instance, it is unclear from this if the diluent is reactive with the polysiloxane, the acrylic polymer or if it is reactive during polymerization. This confuses the breadth of the claims.

2. Applicants' results cited in their response are not sufficient to overcome any of the prior art rejections of record. First, the results must be in the form of a Declaration under 35 CFR 1.132 to be considered. Second, the results are not commensurate in scope with the claims since claim 1 is broadly drawn to "a reactive diluent" while the results show a specific polysiloxane. In addition, without knowing the structure of DC 3074, the Examiner cannot determine whether this polysiloxane is representative of the polysiloxane formula claimed in 1 or if it meets the limitation of, for instance, claim 3.

3. Claims 1, 4, 6, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamaki et al.

In an effort to overcome this rejection applicants note that the acrylic polymer is obtaining in the presence of a reactive diluent. The working examples of Yamaki et al. prepare acrylic polymers in the presence of toluene. This, however, can be considered a reactive diluent since toluene is reactive under some conditions. As such, in view of the breadth given to the term "reactive diluent" applicants' argument is not persuasive.

4. Claim 2 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yamaki et al.

The Examiner has provided supra reasons why the data offered by applicants is not sufficient to overcome this rejection. Applicants have failed to establish that preparing the acrylic polymer in the presence of the polysiloxane forms a different product than an acrylic polymer added to a polysiloxane. As such this rejection is maintained.

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5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaki et al.

Applicants do not specifically traverse the grounds for this rejection, rather, they rely on the arguments addressed supra for claims 1 and 2. Since those rejections are not persuasive, this rejection is also maintained.

6. Claims 1 to 4, 6, 11 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yabuta et al.

With regards to the data supplied by applicants and the term "reactive diluent" the Examiner relies on the rationale supra. Since "reactive diluent" encompasses the xylene diluent in the examples of Yabuta et al., this rejection is maintained.

Applicants also note that Yabuta et al. does not mention that the coatings are ambient curing, but the Examiner has already addressed this issue in the previous office action.

7. Upon reconsideration and in view of applicants' comments, the rejection over Woo et al. has been withdrawn. Specifically the claims are required to be ambient temperature curing. If the silicone resin of Woo et al. was ambient temperature curing, the resulting product would be a cured powder composition that would not be useful. In view of the fact that Woo et al. teach heating the powder to cure, and the fact that one having ordinary skill in the art would not expect or want a powder coating to cure at ambient temperatures, this rejection is withdrawn. In addition the teachings of Woo et al. lead one away from the polysiloxane claimed since Woo et al. prefer a cyclic siloxane.

8. As a minor informality, the Examiner notes that the specification does not provide clear support for the weight limitations of claim 6. While the limitations were present in either the originally filed claims or specification, the specification as it now reads does not specifically teach these values. In an effort to provide a unambiguous patent, the Examiner suggests inserting these weight amounts into the body of the specification.

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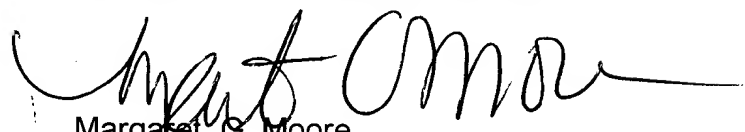
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 703-308-4334. The examiner can normally be reached on Tues. and Thurs. 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9311 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
July 24, 2002